

### REMARKS

Claims 1-13, as amended, and new claims 28-31 are currently pending. In this Response, Applicants have amended certain claims. In light of the Office Action, Applicants believe these amendments serve a useful clarification purpose, and are desirable for clarification purposes, independent of patentability. Accordingly, Applicants respectfully submit that the claim amendments do not limit the range of any permissible equivalents.

In particular, independent claims 1 and 9 have been rewritten to further clarify the embodiments of the present invention recited therein. Various dependent claims have been rewritten or canceled to maintain consistency with the language now recited in the independent claims. Furthermore, claims 28-31 have been added to recited embodiments fully supported by the Written Description. As no new matter has been added, Applicants respectfully request entry of these amendments at this time.

### RESTRICTION REQUIREMENT

The Examiner imposed a Restriction Requirement on the claims originally filed under 35 U.S.C. § 121 as set forth on page 2 of the Office Action. In response, Applicants confirm the election of claims 1-13.

### THE REJECTIONS UNDER 35 U.S.C. §§ 102 & 103

Claims 1-4 and 8-12 were rejected under 35 U.S.C. § 102(b) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over U.S. Patent No. 4,123,061 to Dusbiber ("Dusbiber"). In addition, the Examiner rejected claims 1-4 and 8-12 under 35 U.S.C. § 102(b) or, in the alternative, under 35 U.S.C. § 103(a) as obvious over U.S. Patent No. 6,309,313 to Peter ("Peter"). Moreover, claims 1-3 and 8-12 were rejected under 35 U.S.C. § 102(b) or, in the alternative, under 35 U.S.C. § 103(a) as obvious over U.S. Patent No. 4,124,573 to Watabe ("Watabe"). The Examiner also rejected claims 1-3, 6, and 8-13 under 35 U.S.C. § 102(b) or, in the alternative, under 35 U.S.C. § 103(a) as obvious over U.S. Patent No. 6,018,012 to Crast ("Crast"). Claims 1-3, 6, and 8-13 were also rejected 35 U.S.C. § 102(b) or, in the alternative, under 35 U.S.C. § 103(a) as obvious over U.S. Patent No. 5,459,220 to Kennedy ("Kennedy"). Claims 1-4 and 8-12 were also rejected 35 U.S.C. § 102(b) or, in the alternative, under 35 U.S.C. § 103(a) as obvious over U.S. Patent No.

5,484,870 to Wu ("Wu '870"). The Examiner also rejected claims 1-13 under 35 U.S.C. § 102(b) or, in the alternative, under 35 U.S.C. § 103(a) as obvious over U.S. Patent No. 6,476,176 to Wu ("Wu '176"). Finally, claims 1-13 were rejected under § 102(a, e) or § 103(a) as obvious over U.S. Patent Publication No. 2003/0096936 ("Wu '936"). None of the cited references disclose or suggest the present invention for at least the reasons that follow.

*Dusbiber, Peter, Watabe, and Wu '870*  
*Do Not Anticipate or Render Obvious the Present Invention*

Dusbiber, Peter, Watabe, and Wu generally disclose polyurethane cover compositions for golf balls that include prepolymers that are cured with various curing agents. As recognized by the Examiner, all of these references are completely silent as to the features of claims 7 and 13, portions of which are now recited in both independent claims 1 and 9. As such, Applicants respectfully submit that none of these references anticipate or render obvious the presently recited invention. Thus, Applicants respectfully request reconsideration and withdrawal of the §§ 102 and 103 rejections based thereon.

*Crast and Kennedy Do Not Disclose or Suggest the Present Invention*

Likewise, both Crast and Kennedy are completely silent as to the features previously recited in claim 7 and now recited (at least partially) in claim 1. With regard to claim 9 and the features now recited therein, Applicants respectfully submit that both Crast and Kennedy are directed to two-component polyurethane top coats for golf balls. *See Abstracts*. In contrast, the golf ball component recited in claim 9 (and those claims depending therefrom) is a structural component of the golf ball with a particular thickness. Neither Crast nor Kennedy disclose a structural layer formed from the recited composition having the recited thickness.

In addition, it would not have been obvious to a skilled artisan to use the coatings disclosed by Crast and Kennedy to arrive at the present invention at least because of the differences between structural and coating layers. As those of ordinary skill in the art are aware, a top coat is typically applied at a micron thickness, *e.g.*, 0.1 microns to 100 microns ( $3.93 \times 10^{-6}$  inches to  $3.93 \times 10^{-3}$  inches).

Thus, Applicants respectfully submit that neither Crast nor Kennedy disclose or suggest the present invention. As such, Applicants respectfully request reconsideration and withdrawal of the §§ 102 and 103 rejections based thereon.

Wu '176 Does Not Teach or Suggest the Present Invention

Wu '176 generally discloses golf ball compositions formed from saturated polyurethane components. *See* Abstract. Wu '176 does not teach or suggest, however, the trifunctional curing agents presently recited in claim 1. In addition, Wu '176 does not disclose or suggest the presently recited trifunctional components now recited in claim 9. Thus, in light of the amendments herein, Applicants respectfully request reconsideration and withdrawal of the §§ 102 and 103 rejections based thereon.

Wu '936 Does Not Anticipate or Render Obvious the Present Invention

Like Wu '176, Wu '936 is also silent as to the trifunctional isocyanates and trifunctional curing agents now recited in claim 1 and the trifunctional isocyanates now recited in claim 9. *See* Para 0019 and Para 0087. In particular, Wu '936 does not teach or suggest the particular group of trifunctional curing agents presently recited either in the Written Description or in the claims. *See* Para. 0087 and claim 12. To clarify, claim 6 of Wu '936 recites amines for use in the prepolymer, but does not suggest the use of these amines as a curing agent. In addition, the teachings in Wu '936 regarding suitable saturated isocyanates do not include the trifunctional isocyanates now recited in both claims 1 and 9. *See* Para. 0019.

In addition, Applicants respectfully submit that Wu '936 is unavailable as prior art under § 102(e) under 35 U.S.C. § 103(c). Section 103(c) provides that a § 102(e) reference may not preclude patentability if its subject matter and the claimed invention were commonly owned at the time the invention was made. 35 U.S.C. § 103(c)(2000). *See also*, MPEP § 706.02(l)(1). The present application and Wu '936 were, at the time of invention of this application, owned by Acushnet Company. In support of this, Applicants respectfully direct the Examiner to the assignment filed with this application and the front page of the Wu '936 publication.

For the reasons above, Applicants respectfully submit that Wu '936 does not disclose or suggest the present invention. As such, Applicants respectfully request reconsideration and withdrawal of the §§ 102 and 103 rejections based thereon.

**DOUBLE PATENTING REJECTION**

The Examiner rejected claims 1-13 under the judicially created doctrine of obviousness-type double patenting based on claims 1-27 of U.S. Patent No. 6,835,794. In addition, the Examiner rejected claims 1-13 for obviousness-type double patenting based on claims 1-18 of co-pending U.S. Patent Application No. 10/820,122. In light of the Terminal Disclaimer submitted herewith, Applicants respectfully submit that the double patenting rejections are overcome.

**CONCLUSION**

All claims are believed to be in condition for allowance. If the Examiner believes that the present amendments still do not resolve all of the issues regarding patentability of the pending claims, Applicants invite the Examiner to contact the undersigned attorneys to discuss any remaining issues.

A Petition for Extension of Time is submitted herewith to extend the time for response three months to and including March 1, 2006. In addition, a Fee Sheet Transmittal is submitted to authorize the charge for the Terminal Disclaimer. No other fees are believed to be due at this time. Should any fee be required, however, please charge such fee to Bingham McCutchen LLP Deposit Account No. 195127, Order No. 20002.0331.

Respectfully submitted,

BINGHAM McCUTCHEN LLP

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